REMARKS

This Amendment, filed in reply to the Final Office Action dated June 21, 2010, is believed to be fully responsive to each point of objection and rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Status of the Claims

As of the Final Office Action dated June 21, 2010, claims 21, 22, 33, 36-39 and 43-47 were all the claims pending in the Application and all were rejected. With this response, claims 21, 33, 37-39 and 43-45 are canceled without prejudice or disclaimer. Claim 46 is currently amended.

Support for the claim amendments can be found throughout the specification as filed. Specifically, support for claim 46 can be found from line 23 on page 21 to line 12 on page 22, lines 13-16 on page 22 and in Examples 2 and 3 from line 9 on page 42 to line 13 on page 46 of the specification as filed.

Entry and consideration of this amendment are respectfully requested.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 21, 33, 37-39, 44 and 45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ohuchida et al. (US 6,201,021).

Claims 21, 33, 37-39 and 43-45 are canceled herewith without prejudice or disclaimer. The rejection under 35 U.S.C. § 102(b) as to these claims is therefore moot.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 43, 46 and 47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohuchida et al. (US 6,201,021) as applied to claims 21, 33, 37-39, 44 and 45 in view of Mazo (Pittsburgh Post Gazette, April 12, 2000, pages 1-3).

The Examiner contends the teachings of Ohuchida et al. (US 6,201,021) describe the properties of the compound 2-propyloctanoic acid (i.e. differentiation and/or proliferation of a cerebral nerve stem cell or cerebral nerve precursor cell) and that these properties are inherent to the compound. Hence, according to the Examiner, the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. The Examiner further asserts Ohuchida et al. does not teach that the cells are for transplant but that the Mazo reference teaches that brain cell transplants are known to be successful for the treatment of stroke. Hence, the Examiner alleges that it would have been obvious to a person of ordinary skill at the time of the filing of the present Application to combine the teachings of Ohuchida et al. with those disclosed in Mazo.

Applicant respectfully traverses the rejection.

Claim 43 is canceled without prejudice. Hence the rejection under 35 U.S.C. § 103 as to that claim is moot.

The combination of the Mazo reference with the teachings of the Ohuchida patent fails to teach, suggest or motivate a person of ordinary skill to practice Applicant's invention

With respect to inherency, MPEP § 2112 states the following:

> "V. ONCE A REFERENCE TEACHING PRODUCT APPEARING TO BE SUBSTANTIALLY IDENTICAL IS MADE THE BASIS OF A REJECTION, AND THE EXAMINER PRESENTS EVIDENCE OR REASONING TENDING TO SHOW INHERENCY, **THE BURDEN SHIFTS TO THE APPLICANT TO SHOW AN UNOBVIOUS DIFFERENCE**"
> (Emphasis added)

Applicant asserts Ohuchida et al. (US 6,201,021) teaches the administration of pentanoic acid derivatives for the treatment of ischemia. Specifically, Ohuchida teaches astrocytes cultured in media containing pentanoic acid derivatives show improved function including an increase in Glial Fibrillary Acidic Protein (GFAP) content, $GABA_A$ receptor responses and suppressive effects on cell death in a symbiotic neuron-astrocyte co-culture system. Nothing in Ohuchida teaches, suggests or would motivate a person of ordinary skill to add pentanoic acid derivatives to cultures of glia cells grown on plastic to induce the proliferation of nerve progenitor/ stem cells for transplantation.

Moreover, Mazo et al. fails to remedy the deficiencies of the Ohuchida et al. reference. Mazo et al. is a newspaper article reporting on the treatment of a cerebral stroke victim by transplantation with nerve cells derived from testicular cancer cells. Hence, the Mazo article has no bearing on Applicant's invention which is directed to a method of culturing nerve precursor/ stem cells for transplantation.

Declaration under 37 C.F.R. §1.132

The Applicant also submits concurrently with this Amendment a Declaration under 37 C.F.R. §1.132 in which the Applicant declares why the use of 2-propyloctanoic acid for the culturing and selection for nerve precursor/ stem cells is non-obvious in view of the teachings of Ohuchida et al. (US 6,201,021). Specifically, the Applicant explains why the invention of

amended claim 46 would not have been obvious to a person of ordinary skill at the time of filing of the Application and with knowledge of the Ohuchida prior art reference.

Applicant's discovery that the addition of pentanoic acid derivatives to cultures of glia cells grown on plastic induces the proliferation of nerve precursor/ stem cells is therefore totally unexpected and hence non-obvious.

Prior art must be enabling to anticipate a claimed invention

MPEP 2121.01 states:

> "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, ***the stated test is whether a reference contains an 'enabling disclosure***'... ." In re Hoeksema, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; ***mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation***. Elan Pharm., Inc. v. **>Mayo Found. For Med. Educ. & Research<, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) ....A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." In re Donohue, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

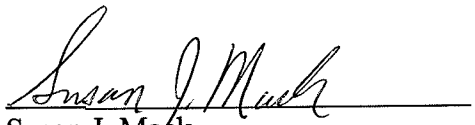
Applicant asserts the Mazo newspaper article contains no description how to culture nerve cells for transplantation or which cells to transplant. Mazo et al is therefore not an enabling prior art reference.

In view of the above arguments, Applicant asserts the claimed invention is not obvious in view of Ohuchida et al. and the Mazo newspaper article. Thus, Applicant respectfully requests that the rejection under 35 U.S.C. § 103 be withdrawn.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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